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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,153	10/17/2003	Lutz Kothe	03-617	9225
34704	7590	09/12/2006	EXAMINER	
BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510			POUS, NATALIE R	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,153	<b>Applicant(s)</b> KOTHE, LUTZ	
	<b>Examiner</b> Natalie Pous	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 11/5/02. It is noted, however, that applicant has not filed a certified copy of the 10251785.1 application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the bead" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the other jaw part" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Dycus et al. (US 7090673).

Regarding Claim 1, Dycus teaches a surgical instrument with a pulling or pushing element (32) for actuating at least one jaw part, wherein the pulling or pushing element is assigned at least one bar (14a).

Regarding Claim 2, Dycus teaches the surgical instrument as claimed in claim 1, wherein two bars are connected to one another (at 15).

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Regarding Claim 3, Dycus teaches the surgical instrument as claimed in claim 2, wherein the two bars are connected via at least one connecting bridge (12), a clamping ring, a guide rivet or the like.

Regarding Claim 4, Dycus teaches the surgical instrument as claimed in claim 1, wherein, at least on one side, the pulling or pushing instrument is supported against a bar via at least one spacer (34).

Regarding Claim 5, Dycus teaches the surgical instrument as claimed in claim 1, wherein the bars and the pulling or pushing element are located in a removable protective tube (500), it is noted removable is a broad term and the tube (500) may be removed if desired.

Regarding Claim 6, Dycus teaches the surgical instrument as claimed in claim 5, wherein an outwardly directed outer contour of the bars (14a, 14b) is shaped to match an inner surface of the tube (500).

Regarding Claim 8, Dycus teaches the surgical instrument as claimed in claim 1, wherein the end of at least one bar is connected to a jaw part in a hinged manner (160, 169).

Regarding Claim 11, Dycus teaches the surgical instrument as claimed in claim 8, wherein the jaw parts are connected to one another at their ends (172, 174) via a hinge pin (170).

Regarding Claim 12, Dycus teaches the surgical instrument as claimed in claim 11, wherein the pulling or pushing element (32) engages (39) on the hinge pin (170).

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashiguchi (US 6063103).

Regarding Claim 13 Hashiguchi teaches a surgical instrument with a pulling or pushing element (8) for actuating at least one jaw part, wherein the pulling or pushing element engages with a bead (14) in a groove in the jaw part (4), and the jaw part engages with a rotating end (proximal end of jaw 4) into a recess (5d) in the other jaw part (5) and rotates with the end in this recess (figs. 4a and 4b).

Regarding Claim 14, Hashiguchi teaches the surgical instrument as claimed in claim 13, wherein the rotating end has an abutment tip (proximal tip of jaw 4) which bears against an inner wall (5d) of the recess.

Claims 1, 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kortenbach et al. (US 6569105).

Regarding Claim 1, Kortenbach teaches a surgical instrument with a pulling or pushing element (146) for actuating at least one jaw part (122), wherein the pulling or pushing element is assigned at least one bar (182).

Regarding Claim 8, Kortenbach teaches the surgical instrument as claimed in claim 1, wherein the end of at least one bar is connected to a jaw part in a hinged manner (170, 172).

Regarding Claim 9, Kortenbach teaches the surgical instrument as claimed in claim 8, wherein the end of the bar has a bead (174) which engages in a groove in the jaw part (166), said groove turning partially about the bead (figs. 6-7).

Regarding Claim 10, Kortenbach teaches the surgical instrument as claimed in claim 8, wherein an end of the bar before the bead is designed to be elastic (figs. 6-7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dycus as a matter of design choice. Dycus teaches all limitations of preceding dependent claims 1 and 5, but fails to teach wherein the protective tube is made of plastic. Dycus does teach wherein the tube is capable of being heat shrunk, and it is well known in the art for heat shrink tubing to be made of plastic. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the material of the outer tube as plastic since it is a well known material for such a function.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NRP  
8/25/06

  
ANHTUAN T. NGUYEN  
SUPERVISORY PATENT EXAMINER  
